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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
0275S-000563

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Application Number
10/072,435Filed
February 8, 2002First Named Inventor
Jason C. ShermerOn June 2, 2006Signature Ryan W. MasseyArt Unit
1745Examiner
Jane J. RheeTyped or printed name Ryan W. Massey

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 38,543.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Ryan W. Massey
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Telephone numberJune 2, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/072,435
Filing Date: February 8, 2002
Applicant: Jason C. Shermer
Group Art Unit: 1745
Examiner: Jane J. Rhee
Title: UNIVERSAL ABRASIVE SHEET
Attorney Docket: 0275S-000563

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF STATEMENT

Sir:

Claims 1, 7-17, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin et al. (U.S. Pat. No. 6,045,887) in view of Simons (U.S. Pat. No. 1,635,350). Claims 2-6, 18-19, and 21-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Martin et al. reference in view of the Simons reference and in further view of Pearce (U.S. Pat. No. 5,367,839). In denying Applicants' request for reconsideration, the Advisory Action repeats verbatim the "Response to Arguments" section of the Final Office Action mailed March 15, 2006. Applicants respectfully traverse these rejections.

35 U.S.C. § 103(a) REJECTION OF INDEPENDENT CLAIMS 1 AND 17

The Examiner acknowledges that Martin et al. fails to disclose or alone suggest an abrasive sheet having a body with a first configuration adapted to be used with a first platen configuration and a second configuration corresponding to a second platen configuration having different external dimensions than the first configuration, as generally set forth in Claims 1 and 17. See September 30, 2005 Office Action at 5. The Examiner alleges that these features are obvious in light of the combination of Martin et al. and Simons.

The Examiner asserts that:

Simons teaches first segments defining regions of weakened material, wherein the sheet material is adapted to be separated along the first segments to change a configuration of the body portion of the sheet material to correspond with a second platen configuration having different external dimension[s] than the first configuration (figure 1 number 4) for the purpose of providing multiple sizes of sand paper (col. 2 lines 48-60).

The score lines 4 creat[e] multiple configurations of the sandpaper wherein each configuration creates different external dimensions

See March 15, 2006 Office Action at 2-3 and April 18, 2006 Advisory Action.

Applicants' respectfully disagree with the Examiner. The back surface of the sand paper disclosed by Simons is provided with a gritty material arranged in stripes 3 that form surfaces that provide a point of friction contact for the user's fingers, thus reducing finger slippage (column 1, lines 30-43). Simons fails to disclose use of the sand paper with two different platens having different configurations and different external dimensions. In fact, Simons fails to disclose or suggest the use of a platen at all. The Simons reference teaches away from using a platen because it only discloses use of the sandpaper by hand.

This Section 103 rejection is improper because it lacks factual support. *Ex parte David L. Robinson, et al.*, Appeal No. 2005-0111, March 18, 2005. The rejection is further improper because the Examiner is resorting to speculation, unfound assumptions, and hindsight reconstruction to fill deficiencies in the factual basis of the rejection. *In re Warner*, 379 F.2d 1011, 1017, 154 U.S.P.Q. 173, 178 (C.C.P.A. 1967). Even if the cited references could be modified as the Examiner asserts, such modifications are not obvious unless the prior art suggested the desirability of the modification. *In re Mills*, 916 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1990). The Examiner fails to provide any evidence or explanation as to why and/or how one of ordinary skill in the art would have been motivated to modify the teachings of the Martin et al. reference in light of the Simons reference to arrive at the claimed invention. The Examiner has improperly inferred from Simons that the reference teaches abrasive sheets having body portions of different dimensions for use with different platen configurations. Accordingly, the Examiner is using an incorrect factual basis and impermissible hindsight to combine the Martin et al. and the Simons references.

35 U.S.C. § 103(a) REJECTION OF INDEPENDENT CLAIM 21

The Examiner acknowledges that Martin et al. fails to disclose or suggest an abrasive sheet having a body portion and a tip portion, the sheet adapted to be separated along second segments of weakened material to separate a first tip portion having a first tip configuration from a first body portion and selectively separated along third segments of weakened material to separate a second tip portion having a second tip configuration different from the first tip configuration from a second body portion, as generally set forth in Claim 21. See September 30, 2005 Office Action at 7.

However, the Examiner asserts that these features are obvious in light of the combination of Martin et al. along with Pearce and Simons. Specifically, the Examiner asserts that:

Pearce teaches a plurality of segments that define regions of weakened material wherein the sheet is adapted to be separated along two different segments (figure 1 number 2 and 2') for the purpose to correspond with a plurality of different sanding machines within the size range for that sheet (col. 2 lines 60-62). Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Martin et al. with a third segment that separates a second tip portion having a second tip configuration that is different from the first tip configuration in order to correspond with a plurality of different sanding machines

See March 15, 2006 Office Action at 4 and April 18, 2006 Advisory Action.

Applicants respectfully disagree with the Examiner. The Simons and Pearce references each fail to disclose or render obvious abrasive sheets having a tip portion at all and particularly fail to disclose or suggest a tip portion with first and second tip configurations provided by separating the tip portion from the body portion along different segments of weakened material.

With respect to the Pearce reference, Pearce does not suggest modifying Martin to have different segments defining regions of weakened material to provide for first and second tip portions having first and second configurations. Pearce merely teaches an alternative hole pattern to correspond to different sanders and is completely silent with respect to different tip configurations. Pearce fails to disclose or suggest a removable tip portion at all.

While the Simons reference is cited in the Section 103 rejection of Claims 2-6, 18-19, and 21-23, it does not appear that the Examiner is using Simons to reject independent Claim 21. Regardless, the Simons reference fails to disclose or suggest

an abrasive sheet having a body portion and a tip portion, the sheet adapted to be separated along second segments to separate a first tip portion having a first tip configuration from a first body portion and selectively separated along third segments to separate a second tip portion having a second tip configuration different from the first tip configuration from a second body portion.

This Section 103 rejection is improper because it lacks factual basis. *Ex parte David L. Robinson, et al.* The Examiner is impermissibly resorting to speculation, unfound assumptions, and hindsight reconstruction to fill deficiencies in the factual basis of the rejection. *In re Warner*, 154 U.S.P.Q. at 178. Even if the references could be modified as the Examiner asserts, such modifications are not obvious unless the prior art suggested the desirability of the modification. *In re Mills*, 221 U.S.P.Q. at 1127. The Examiner fails to provide any evidence or explanation as to why and/or how one of ordinary skill in the art would have been motivated to modify the teachings of the Martin et al., the Pearce, and the Simons references to arrive at the claimed invention.

CONCLUSION

For the reasons set forth herein, Applicants respectfully request reconsideration and withdrawal of the Section 103 rejections of independent Claims 1, 17, and 21 and those claims dependent therefrom.

Dated: June 2, 2006

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Respectfully submitted,

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